

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed March 19, 2008. At the time of the Office Action, Claims 33-44, 46-53, 55, 56, 58-63, 65-70, and 72-75 were pending in this Application. Claims 40-44, 55-56, 58-60, 62-63, 65-70 and 72-75 were rejected and claim 61 was objected to. Claims 33-39 and 46-53 were previously withdrawn from consideration by the Examiner. Claims 45, 54, 57, 64 and 71 were previously cancelled by Applicant without prejudice or disclaimer. Claims 44, 61, 62, and 74 have been amended to further define various features of Applicant's invention. Claims 63 and 75 have been cancelled without prejudice or disclaimer. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 40, 42, 44, 55, 56, 58, 59, 62, 63, 65, 66, 69 and 73-75 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,512,610 issued to Lin ("Lin").

Claim 74 was rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,258,028 issued to Ersek et al. ("Ersek"). Applicant respectfully traverses and submits the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the art cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

With regard to claims 40, 62, and 74, the Examiner contends that Lin discloses an injectable implant composition comprising a settable hardenable flowable matrix, radiopaque tracer particles and radiopaque contrast particles. However, Lin does not disclose a composition having two different size ranges of radiopaque particles. The Examiner points to the disclosure in Lin of different polymer bead sizes as describing varying size ranges of components in the

injectable implant composition. The polymer beads described by Lin teach components which contain only one size of radiopaque particle (i.e., barium sulfate in the form of a fine powder comprising particles approximately 1µm in size). Therefore, while the polymer beads may be described to be found in varying size ranges, the radiopaque particles found within the polymer beads are only recited as being of a single size. Additionally, the Examiner conflates the teachings of Lin by stating that because beads 13 have barium sulfate particles 15 therein, the entire bead 13 is rendered radiopaque. Certainly, the disclosure of Lin teaches that the beads contain an opacifier, but it cannot be said that Lin teaches that the beads themselves are radiopaque as a whole. Rather, only the particles contained in beads 13 are radiopaque. In contrast, claims 40, 62, and 74 recite an injectable implant composition comprising radiopaque tracer particles and contrast particles of two different particle size ranges. Because Lin only discloses one size range of radiopaque particle, it does not describe every element of claims 40, 62, and 74 and therefore cannot anticipate these claims. Applicant respectfully submits that claims 40, 62, and 74, and all claims that depend therefrom, are in condition for allowance and requests withdrawal of the rejection.

With regard to claim 74, Ersek does not disclose a flowable matrix that is settable hardenable, as is now recited by amended claim 74. Rather, Ersek contemplates the use of physiologic vehicles that are “removed or metabolized” which precludes the description of a settable hardenable implant composition. Therefore, Ersek does not describe all the elements of claim 74 as amended, and cannot anticipate claim 74 as amended. Applicant submits that claim 74 as amended is in condition for allowance and requests withdrawal of the rejection.

Rejections under 35 U.S.C. §103

In the alternative to the above rejection, Claim 74 was rejected under 35 U.S.C. §103(a) as being unpatentable over Ersek. Applicant respectfully traverses and submits the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

Claims 40-44, 55-56, 58-59, 62-63, 65-66 and 68-70 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,507,813 issued to Dowd et al. (“Dowd”) in view of U.S. Patent No. 4,500,658 issued to Fox (“Fox”). Applicant respectfully traverses and

submits the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

Claims 60, 67 and 72 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lin. Applicant respectfully traverses and submits the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

When determining whether a claim is obvious, the Examiner must make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, it is well settled that obviousness requires at least a suggestion of all the features in a claim. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (*citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, “*there must be some articulated reasoning* with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

With regard to claim 74, Applicant repeats and hereby incorporates the above statements with regard to Ersek. Ersek does not disclose a flowable matrix that is settable hardenable, as is now recited by amended claim 74. Rather, Ersek contemplates the use of physiologic vehicles that are “removed or metabolized” which precludes the description of a settable hardenable implant composition. Therefore, Ersek does not describe all the elements of claim 74 as amended, and cannot render obvious claim 74 as amended. Applicant submits that claim 74 as amended is in condition for allowance and requests withdrawal of the rejection.

With regard to claims 40 and 62, Dowd does not suggest a flowable matrix having radiopaque particles of two distinct and different size ranges, as is recited in claims 40 and 62. Dowd suggests only the use of bone particles having a size between 2 to about 200mm, but does not suggest the use of two distinct and different size ranges of bone particles. As stated above, claims 40 and 62 recite an injectable implant composition comprising radiopaque tracer particles and contrast particles of two different particle size ranges. Dowd arguably contemplates the

inclusion of varying sizes of bone particles, but neither expressly nor impliedly suggests the presence of bone particles falling within two different and distinct particle size ranges. Because neither Dowd nor Fox at least suggest all the elements of claims 40 and 62, neither Dowd nor Fox, alone or in combination, render obvious claims 40 and 62. Applicant respectfully submits that claims 40 and 62, as well as all the claims that depend directly or indirectly therefrom, are in condition for allowance and request withdrawal of the rejection.

With regard to claims 60, 67, and 72, Applicant repeats and hereby incorporates the above comments with regard to the teachings of Lin. Applicant submits that claims 60, 67, and 72 are in condition for allowance, and requests withdrawal of the rejection.

Allowable Subject Matter

Applicant appreciates Examiner's consideration and indication that Claim 61 would be allowable if rewritten in independent form and to include all of the limitations of the base claim and any intervening claims. Applicant has amended claim 61 to include all of the elements of base claim 40 and intervening claim 60, and respectfully submits that claim 61 as amended is in condition for allowance.

CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

Applicant believes there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.358.5925.

Respectfully submitted
Attorney for Applicant,



Matthew Scheele
Reg. No. 59,847

Date: _____

7/16/08

CORRESPONDENCE ADDRESS:

ARTHROCare CORPORATION

CUSTOMER NO. **21394**

512.358.5925

512.391.3901 (fax)